UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/600,483	BENKERT ET AL.
	Examiner	Art Unit	
	MARTIN A. GOTTSCHALK	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 June 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-4, 9-23 and 41-61</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-4,9-23 and 41-61</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>10/08/2003</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   Claims 1-4, 9-23, and 41-61 have been examined. Claims 5-8 and 24-40

are cancelled.

Election/Restrictions

2.   Applicant's election without traverse of claims 1-4, 9-23, and 41-61 in the

reply filed on 06/02/2008 is acknowledged.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 48-61 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

5.   Claim 48 recites the limitation "said account domestic payment network

system code". There is insufficient antecedent basis for this limitation in the

claim. The remaining claims depend from claim 48 and are thus rejected as well.

Claim Rejections - 35 USC §101

6.   35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

7.   **Claims 1-4 and 9-23** are rejected under 35 U.S.C. §101 because the

claimed invention is directed to non-statutory subject matter.

8.   Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184

(1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409

U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent

Federal Circuit decisions, §101 process must (1) be tied to another statutory

class (such as a particular apparatus) or (2) transform underlying subject matter

(such as an article or materials) to a different state or thing (the Supreme Court

recognized that this test is not necessarily fixed or permanent and may evolve

with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

9.   If neither of these requirements is met by the claim(s), the method is not a

patent eligible process under 35 U.S.C. §101.

10.   In this particular case, regarding the first test, in performing the steps of

the claimed subject matter, there is no requirement that a machine be used, thus

the claims are not considered sufficiently tied to another statutory class.

Regarding the second test, since the claimed subject matter may be performed

using only human intelligence, the steps do not sufficiently transform the

underlying subject matter to be statutory.

11.   **Claims 41-61** is also rejected under 35 U.S.C. 101 because the claimed

invention is directed to neither a process, a machine, a manufacture, nor a

composition of matter, but rather embraces and/or overlaps multiple statutory

classes of invention which 35 U.S.C. 101 is designed to prevent. In Ex parte

Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). For example, though claim

1 is a method claim, claim 41 refers to the "system claim of claim 1" then

proceeds to recite system features to this and subsequent dependent claims.

Claim Rejections - 35 USC § 102

12.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13.   Claims 1-4, 9-23, and 41-45 are rejected under 35 U.S.C. 102(e) as being

anticipated by Solokl et al (US Pat# 6,173,269).

As per claim 1, Solokl teaches a method for facilitating the administration of a

subsidiary account comprising the steps of:

receiving a request from a parent for a subsidiary account, said parent

identifying a parent account, said parent account being a financial account

associated with the parent, the parent account having a parent spending

power (Solokl: col 4, lns 12-21; lns 35-41; col 8, lns 55-65);

establishing a subsidiary account having a subsidiary spending capacity

(Solokl; col 8, lns 58-61);

and reducing said parent spending power by an amount less than said

subsidiary spending capacity (Solokl: col 4, lns 12-21; lns 35-41;)

wherein said parent account is established by a first institution and said

subsidiary account is at least partially maintained by a second institution

(Solokl: col 5, lns 33-46; col 10, lns 3-6).

As per claim 2, Solokl teaches a method according to claim 1, wherein said

subsidiary account is fully maintained by said second institution (Solokl: col 5, lns

33-46; col 10, lns 3-6).

As per claim 3, Solokl teaches the method of claim 1, wherein said second

institution is situated in a location remote from said first institution (Solokl: col 5,

lns 33-46; col 10, lns 3-6).

As per claim 4, Solokl teaches the method of claim 1, wherein said second

institution is situated in a country that is different from the country of said first

financial institution (Solokl: col 9, lns 54-56).

As per claim 9, Solokl teaches the method of claim 1 further comprising the step

of modifying said subsidiary spending capacity in response to a request from said

parent. (Solokl: col 9, lns 17-25).

As per claim 10, Solokl teaches the method of claim 9, further comprising the

step of modifying said parent spending power based on a modification of the

subsidiary spending capacity (Solokl: col 9, lns 16-24).

As per claim 11, Solokl teaches the method of claim 1, further comprising the

step of determining a parent spending power for the parent account and a

subsidiary spending capacity for the subsidiary account in accordance with a

predetermined set of rules (Solokl: col 6, lns 63-66; col 9, lns 16-24).

As per claim 12, Solokl teaches the method of claim 1, further comprising the

step of tracking the spending of a subsidiary account (Solokl: col 6, lns 35-49).

As per claim 13, Solokl teaches the method of claim 1, further comprising the

step of limiting total spending facilitated by a subsidiary account (Solokl: col 9, lns

16-24).

As per claim 14, Solokl teaches the method of claim 1, further comprising the

step of limiting spending for a specific class of goods or services facilitated by a

subsidiary account (Solokl: col 6, lns 6-8).

As per claim 15, Solokl teaches the method of claim 1, further comprising the

step of limiting spending at a specific class of merchants facilitated by a

subsidiary account (Solokl: col 6, lns 1-3).

As per claim 16, Solokl teaches the method of claim 1, further comprising the

step of limiting spending at a specific merchant facilitated by a subsidiary account

(Solokl: col 6, lns 1-3).

As per claim 17, Solokl teaches the method of claim 1, further comprising the

step of enforcing specific restrictions against a subsidiary account, wherein the

specific restrictions exist to condition the use of the parent account (Solokl: col 8,

lns 13-15).

As per claim 18, Solokl teaches the method of claim 1, further comprising the

step of accommodating an emergency transaction account (Solokl: col 9, lns 25-

30).

As per claim 19, Solokl teaches the method of claim 1, further comprising the

step of generating a statement for a subsidiary account (Solokl: col 6, lns 35-39).

As per claim 20, Solokl teaches the method of claim 1, further comprising the step of generating a statement for a parent account (Solokl: col 6, lns 1-3).

As per claim 21, Solokl teaches the method of claim 1, further comprising the step of terminating said subsidiary account in response to a request from said parent (Solokl: col 9, lns 19-24).

As per claim 22, Solokl teaches the method of claim 1, wherein said subsidiary account is configured to carry-over spending capacity from one cycle to the next (Solokl: col 8, lns 55-65).

As per claim 23, Solokl teaches the method of claim 1, wherein said subsidiary account is configured to prevent carry-over of spending capacity from one cycle to the next (Solokl: col 8, lns 55-65).

As per claim 41, Solokl teaches the system of claim 1, further comprising:

a merchant system at least a portion of which is located domestically (Solokl: col 5, lns 18-22) said merchant system including a merchant server (Solokl: col 5, lns 47-50), said merchant server configured to receive at least one of an account number and a transaction request (Solokl: col 7 ln 60 to col 8, ln 17);

a customer interface configured to provide said account number to said domestic

merchant server (Solokl: Fig 1, item 24; col 8, lns 6-10);

and

a foreign financial institution system configured to communicate with said

merchant server (Solokl: Fig 1, item 29, col 5, lns 18-29; col 9, lns 50-56).

As per 42, Solokl teaches a system according to claim 41, wherein said

merchant system further includes a merchant point of sale (POS) device

configured to communicate with said customer interface and said merchant

server, said POS device configured to receive said account number and provide

said account number and a transaction request to said merchant server (Solokl:

Fig 1, item 24, col 6, lns 16-18).

As per claim 43, Solokl teaches a system according to claim 41, wherein said

subsidiary account is reloadable (Solokl: col 8, lns 55-65).

As per claim 44, Solokl teaches a system according to claim 41, wherein said

subsidiary account is fully maintained by a foreign financial institution Solokl: Fig

1, item 29, col 5, lns 18-29; col 9, lns 50-56).

As per claim 45, Solokl teaches a system according to claim 42, wherein said

foreign financial institution system further includes a financial institution server

configured to communicate with said merchant server (Solokl: Fig 1, items 25-

29).

As per claim 46, Solokl teaches a system according to claim 45, wherein said

foreign financial institution system further includes a financial institution database

configured to communicate with said financial institution server, said financial

institution database including a plurality of distinct subsidiary account storage

locations wherein at least one of said plurality of distinct subsidiary account

storage locations stores a unique subsidiary card number, said unique subsidiary

card number corresponding to said subsidiary account number (Solokl: col 3, lns

35-39; col 4, lns 23-35; col 6, lns 40-50).

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

15.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.,* 383 U.S. 1,

148 USPQ 459 (1966), that are applied for establishing a background for

determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

> 2. Ascertaining the differences between the prior art and the claims at issue.
> 3. Resolving the level of ordinary skill in the pertinent art.
> 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 47-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solokl as applied to claim1 above, and further in view of Barbara et al (US PG Pub# 2002/0016769).

As per claim 47, Solokl fails to explicitly disclose the use of routing codes, however this is taught by Barbara (Barbara: [0095]).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Barbara with the system of Solokl with the motivation to extending the use of the subsidiary account of Solokl to include receiving person-to-person payments, other than those from the parent account (Barbara: [0020]).

Note: Unless otherwise stated, the motivation to combine the Solokl and Barbara references for any subsequent claim rejections is the same as that provided above for claim 47.

As per claim 48, Barbara teaches a system according to claim 47, wherein said merchant server provides said subsidiary account number and said transaction request to said financial institution server, in accordance with at least one of said

account domestic payment network system code and said unique transaction

routing code (Barbara: [0095]).

As per claim 49, Solokl teaches a system according to claim 48, wherein said

foreign financial institution server is configured to match said account number to

said corresponding one of said plurality of subsidiary card numbers, said foreign

financial institution server further configured to retrieve said corresponding

subsidiary card number in response to said transaction request, said subsidiary

card number including subsidiary account information (Solokl: Fig 1, items 20-

31).

As per claim 50, Solokl teaches a system according to claim 49, wherein said

subsidiary card number is characterized by a predetermined monetary value

(Solokl: col 9, lns 16-24).

As per claim 51, Solokl teaches a system according to claim 50, wherein said

foreign financial institution server is configured to compare said transaction

request to said predetermined monetary value, and provide to said merchant

system at least one of a transaction authorized or transaction denied message,

said transaction authorized message being provided where said transaction

request is less than or equal to said predetermined monetary value, said

transaction denied message being provided where said transaction request is

more than said predetermined monetary value (Solokl: col 8, lns 13-15).

As per claim 52, Solokl teaches a system according to claim 51, wherein said

financial institution is characterized by a financial institution domestic payment

network system code, said financial institution domestic payment network system

code corresponding to said account domestic payment network system code

(Solokl: col 8: 13-15).

As per claim 53, Solokl teaches a system according to claim 52, wherein said

financial institution server is configured to provide a monetary amount to said

merchant server in response to said transaction request. (Solokl: col 8, lns 16-81).

As per claim 54, Barbara teaches a system according to claim 53, wherein said

financial institution server is configured to provide said monetary amount in

accordance with existing monetary exchange rates (Barbara: [0016]).

As per claim 55, Barbara teaches a system according to claim 54, wherein said

subsidiary card number is characterized by an expiration date, and said

transaction request is characterized by a transaction request date (Barbara:

[0016]; [0034]-[0054]).

As per claim 56, Solokl teaches a system according to claim 55, wherein said

merchant system server provides said transaction request date to said financial

institution system server (Solokl: Fig 1, in particular note arrows between items

28, 20, and 30).

As per claim 57, Solokl teaches a system according to claim 56, wherein said

financial institution server is configured to compare said transaction request date

to said expiration date, said merchant server further configured to return a

transaction denied message where said transaction date occurs later in time than

said expiration date (Solokl: col 8, lns 13-15 and 49-50).

As per claim 58, Solokl teaches a system according to claim 57, further including

a sponsor configured to communicate with said financial institution system server,

said sponsor configured to provide said predetermined monetary value to said

financial institution for establishing said subsidiary account spending limit, said

spending limit corresponding to said predetermined monetary amount, said

predetermined monetary value provided in a currency capable of being processed

by said financial institution system (Solokl: col 9, lns 16-24).

As per claim 59, Solokl teaches a system according to claim 58, wherein said

financial institution server is configured to reload said spending limit in response

to said provided predetermined monetary value (Solokl: col 8, lns 58-62).

As per claim 60, Barbara teaches a system according to claim 59, wherein said

sponsor is configured to provide an updated expiration date to said financial

institution server, said updated expiration date corresponding to at least one of

said subsidiary card numbers, said updated expiration date configured to replace

said subsidiary card expiration date correlating to said one of said subsidiary

accounts (Barbara: [0016]).

As per claim 61, Barbara teaches a system according to claim 60, wherein said

financial institution server is configured to provide a portion of said predetermined

monetary value to said sponsor at said expiration date, said portion of said

predetermined value being provided in the currency of the country of at least one

of said foreign financial institution and said sponsor (Barbara: [0076]; [0080];

[0085]; [0087]; [0095]).

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The cited but not applied prior art teaches multi-account

systems including primary and subsidiary accounts; and systems for making

foreign purchases with settlement. including foreign currency exchange.

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to MARTIN A. GOTTSCHALK whose telephone

number is (571)272-7030. The examiner can normally be reached on Mon - Fri

8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The

fax phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or Public

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-

9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

/Martin A. Gottschalk/
Examiner, Art Unit 3696